

REMARKS

In summary, claims 1-23 are pending. Claims 1-9 and 19-23 are rejected under 35 U.S.C. § 112. Claims 1-8, 10-17, and 19-23 are rejected under 35 U.S.C. § 101. Claims 1-6, 8-16, 18, 19, and 21-23 are rejected under 35 U.S.C. § 102. Claims 7, 17, and 20 are rejected under 35 U.S.C. § 103. Claims 1, 10, and 19 are amended herein. No new matter is added.

Telephone Conversation With Examiners

Applicant's representative thanks Examiners Liu and Swearingen for the telephone conversation conducted on January 7, 2008. During the conversation, Examiners Liu and Swearingen discussed, as best they could, how the Tracey reference was being asserted against the claims. Also, the Examiners agreed to reconsider the term "consolidating" recited in the claims. Further, Applicant's representative agreed to add a claim limitation directed to storing a result of the step of determining.

Claim Rejections - 35 U.S.C. § 112

Claims 1-9 and 19-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because, as asserted in the instant Office Action, the term "consolidating" recited in independent claims 1 and 19 is indefinite.

Applicant respectfully submits that the term "consolidating" is not indefinite. The use of the term "consolidating" is consistent with its plain ordinary meaning. Per MPEP § 2111.01, "the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. ... English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say."

The plain meaning of the term "consolidating" can be found in a dictionary. For example, the word consolidate (root of the term consolidating) is defined in <http://www.dictionary.reference.com>, as: "to bring together (separate parts) into a single or unified whole; unite; combine", "to unite or combine", "[t]o unite one system or whole;

combine". Additionally, the use of the term "consolidating" in Applicant's specification is not inconsistent with these definitions. For example, see paragraphs [0009], [0044], [0045], [0051], [0053], [0054], and [0055].

Because the term "consolidating" is used in accordance with its plain ordinary meaning, it is requested that the rejection of claims 1-9 and 19-23 under 35 U.S.C. § 112 be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. § 101

Claims 1-8, 10-17, and 19-23 are rejected under 35 U.S.C. § 101 because, as asserted in the instant Office Action, claim 1 is not directed to a useful, tangible, result; claim 1 recites a condition; claim 10 recites a condition; and claim 19 is directed to software alone.

Without prejudice or disclaimer as to whether claims 1 and 10 provide a useful, concrete, and tangible result, independent claims 1 and 10 are herein amended to recite "storing an indication of a result of the step of determining." Thus, amended claims 1 and 10 provide a useful, concrete, and tangible result: the provision of the determination as to whether a plurality of actions are available to be performed in connection with a context entity.

With respect to the condition statement in claims 1 and 10, it is submitted that the amendments to claims 1 and 10 render the rejection moot.

Without prejudice or disclaimer as to whether claim 19 is per se non-statutory, claim 19 is amended to recite "a computer-implemented context entity". Thus, claim 19 is not limited to software alone.

In view of the foregoing amendments and arguments, it is requested that the rejection of claims 1-8, 10-17, and 19-23 under 35 U.S.C. § 101 be reconsidered and withdrawn.

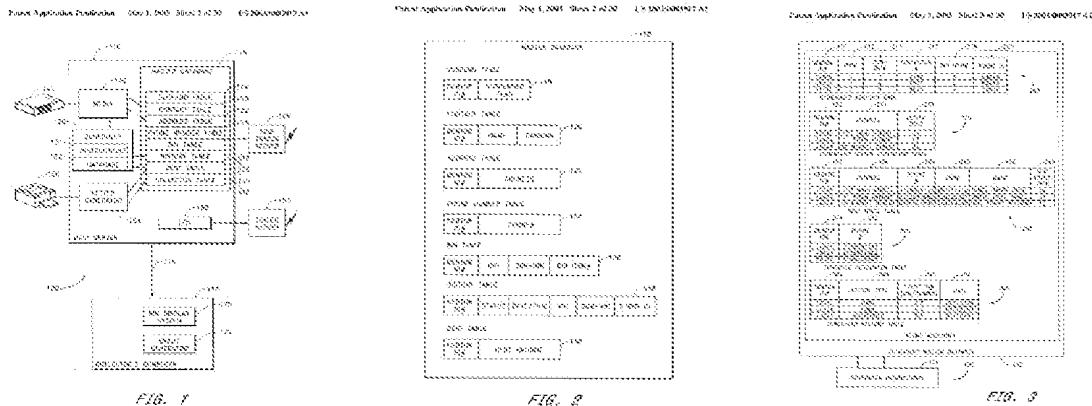
Claim Rejections - 35 U.S.C. § 102

Claims 1-6, 8-16, 18, 19, and 21-13 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0083917 in the name of Tracey *et al.* (hereinafter referred to as “Tracey”).

It is respectfully submitted that a prima facie case of anticipation under 35 U.S.C. § 102 has not been established because no rationale or explanation has been provided as to how Tracey is being asserted against the claims.

Applicant does not understand how Tracey is being asserted against the claims. The reference to Tracey lacks enough information to assess how Tracey is being applied. Support is not provided for each claim limitation being rejected. In the instant Office Action, references to Tracey comprise nothing more than a parenthetical reference to figures and/or paragraphs in Tracey. No rationale is provided explaining how Tracey is being asserted against the claims. For example, with respect to claim 1, it is stated that “Tracey teaches a method for determining if a plurality of actions are available to be performed in connection with a context entity, the context entity being derived from a plurality of related service entities at a plurality of application service (Tracey, figures 1-3).”

Figures 1, 2, and 3 of Tracey are reproduced herein for convenience. Neither Figure, 1, 2, nor 3 depicts a method. Thus, it is not clear how Figures 1, 2, and 3 are being asserted against the method claims. Further, as evident below, Figures 1, 2, and 3, depict numerous elements. It is not clear what elements of Figures 1, 2, and 3, are being interpreted to correspond to claim limitations.



For example, it is not clear which elements in Figures 1, 2, and 3 correspond to at least:

- a context entity
- a plurality of related service entities
- a plurality of application services

Without providing rationale as to how a reference is being asserted against a claim, the burden to clearly articulate the rejection has not been met. “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and other wise reply completely at the earliest opportunity.” (Emphasis added) MPEP § 706. “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference ... shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of reference, if not apparent, must be clearly explained and each rejected claim specified.” (emphasis added) 37 § CFR 1.104 (c)(2), MPEP 706. To anticipate a claim, a reference must teach every claimed element. MPEP § 2131. Furthermore, the examiner bears the burden of proof to show patent invalidity. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). Such proof must amount to a preponderance of the evidence to warrant rejection of claims. *Id.* Because the rejection of the claims has not been clearly explained in view of *Tracey*, this burden has not been met.

Additionally, Figures 12 and 13, and paragraphs 80, 100, and 247, of Tracey, are cited as teaching “classifying actions for a plurality of service entities at the plurality of application services, each action being classified according to its availability.”

It is still not clear how the cited portions of Tracey are being interpreted to teach “classifying actions for a plurality of service entities at the plurality of application services, each action being classified according to its availability.” Tracey teaches a method of managing workflow information. As stated in paragraph 80 of Tracey, “a workflow management system” is used “to track and coordinate the progress of orders in a sales office”, such as “in a grocery store to notify a receiving clerk about new products, to notify a stock person that new goods are available, and to notify management that items have been received and stocked on shelves.” Paragraph 100 further teaches that a “user has the flexibility to select which account to work, based upon his or her own preferences, strengths and efficiencies”, and that “the system includes automation of movement from bin-to-bin on the basis of events”, thus automatically providing the user “with information that is readily available to assist the user in his/her decision making.” Finally, paragraph 247 teaches that the system provides “flexibility for allowing [a] collector to choose options without having to memorize codes, or refer to other lists of potential options to enter into the system.

If Examiner wishes to maintain the rejection of the claims, Applicant requests to be provided in another non-final Office Action the portions of Tracey being used to support the rejection of each claim limitation along with an explanation of how each of the respective portions of Tracey is being applied. Alternatively, it is requested that the rejection of claims 1-6, 8-16, 18, 19, and 21-13 be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. §103

Claims 7, 17, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tracey in view of U.S. Patent Application Publication No. 2005/0021355 in the name of Brendle *et al.* (hereinafter referred to as “Brendle”).

The arguments and remarks provided above with respect to rejections based on Tracey, under 35 U.S.C. § 102 also apply to the rejection of claims 7, 17, and 20 under 35 U.S.C. § 103.

Additionally, a *prima facie* case of obviousness has not been established because the proposed modification of the Tracey and Brendle necessary to arrive at the claimed subject matter has not been provided.

Per a recent update to MPEP § 706.02(j) to include examination guidelines in view of *KSR v. Teleflex*, 35 § U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 § U.S.C. 103, the examiner should set forth in the Office action: (1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Because no explanation of how Tracey and/or Brendle would have to be modified to arrive at Applicant's claims, a *prima facie* case of obviousness has not been established.

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PATENT

In view of the foregoing remarks, it is requested that the rejection of claims 7, 17, and 20 under 35 U.S.C. § 103 be reconsidered and withdrawn.

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PATENT

CONCLUSION

In view of the foregoing arguments, remarks, and amendments, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow this application for any reason, the Examiner is encouraged to contact the undersigned attorney to discuss resolution of any remaining issues.

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